REMARKS

By this Amendment claim 1 has been revised to address and overcome the examiner's rejection thereagainst under 35 U.S.C. 112, and claims 15 and 16 have been amended to be in independent form. Entry is requested.

In the outstanding final Office Action the examiner has (1) rejected claims 1, 9-12 and 17 under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. in view of Tooth et al., (2) rejected claims 2-8 and 12-14 under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. in view of Tooth et al., Isherwood et al. and Crane, (3) rejected claims 15 and 16 under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. in view of Tooth et al. and Merry, and (4) rejected claim 18 under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. in view of Tooth et al. and Isherwood et al.

The inventor asserts these rejections are incorrect.

Murakami et al. disclose a method of manufacturing a window paper having a threaded inserted therein; however, the windows do not extend completely through the paper. They do disclose at least an edge of the thread being exposed in the windows in the one surface of the paper. Tooth et al., on the other hand, although disclosing holes which expose the thread on both sides of the paper, does not disclose that at least one edge of the security thread is exposed in the holes.

The inventor asserts that it would not be obvious to a person of ordinary skill in the art to combine the teachings of Murakami et al. and Tooth et al. Murakami et al. describe a process in which a web of paper in which a thread has already been embedded is brought into contact with a roll which has protrusions. A friction roll forces the underside of the paper web over and around the protrusions and scrapes paper fibres lying on the other side of the thread away to expose the thread.

In Tooth et al., on the other hand, the paper is formed using a cylinder mould method in which the cylinder rotates in a vat of paper furnish and the thread is brought into contact with the protrusions on the cylinder mould either before (Figure 1) or after (Figure 6) the paper fibres are deposited. As subsequent fibres are deposited, the thread becomes embedded in the paper as it is formed. This leaves the thread exposed in windows on one side of the paper. To expose it on the other side, it is necessary to make the impervious projections larger relative to the mean fibre length of the paper making stock (column 6, lines 44 to 46). Since this would have no impact at all on the method of Murakami et al., and it would not be possible to scrape both sides of the paper to create windows in both sides using the method described in Murakami et al., it must be concluded that both methods are wholly incompatible. A person of ordinary skill in the art would not, and indeed could not, take a feature from Tooth et al. and add it to the method of Murakami et al. to create the method defined in the present application, or create the substrate of

the present invention. As such, claim 1 is not obvious over these two documents.

Nothing in Isherwood et al. or Crane would overcome the basic deficiency in the examiner's attempted combination of Murakami et al. and Tooth et al. to reject claim 1.

With respect to the examiner's rejection against claims 15 and 16 (now presented in independent form), Merry describes a purely printed feature for marking the edges of an unbound book to show where a page has been removed. The marking is not an aperture, which is much more difficult to create. In Merry the intention is that the book is inspected statistically with the pages closed. In the present invention, the booklet comprising the sheets of substrate having the aperture at staggered positions are bound together and, as explained at page 10, lines 35 to page 11, line 6, when the pages are flicked through at a reasonable speed, this gives the impression of an aperture moving and therefore provides a simple form of verification.

An allowance of the present claims is in order.

Respectfully submitted,

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